

### REMARKS

In paragraphs 1 and 2 of the Office Action claims 19-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al (US 5,995,342), stating:

“Claims 19 and 25, Cohen et al shows a thin film device in Figs. 1A and 2 including: at least one thin film layer 16; at least one component 32A; the component being formed with an overplated head (the whole portion above 16) that includes overhang portions 28; hard baked photoresist 40 (Column 18, lines 40-49) being disposed beneath the overhang portions to fill an area beneath the overhang portions 28.”

Claim 25, Cohen further shows the thin film device is inherently used to an hard disk drive (Column 1, lines 12-47), including: at least one hard disk being adapted for rotary motion upon a drive device; at least one slider device having a slider body portion being adapted to fly over the hard disk; a magnetic head being formed on slider body for writing data on the hard disk.

Claims 20 and 26, Cohen et al further shows that the component 32A is formed into an opening formed in a photoresist layer (Column 13, lines 3-6).

Claims 21 and 27, Cohen et al further shows that the device is a thin film magnetic head.

Claims 24 and 30, Cohen et al further shows in Fig. 3(a) that the component 32A is an electrical interconnecting stud.

Claims 22/19 and 28/25 Cohen et al shows a thin film device in Figs. 1A and 2 including: at least one thin film layer 16; at least one component 20; the component being formed with an overplated head (the whole portion above 16) that includes overhang portions 28; hard baked photoresist 40 (Column 18, lines 40-49) being disposed beneath the overhang portions to fill an area beneath the overhang portions 28; the component 20 is a yoke portion of a magnetic pole.

Claims 23 and 29, Cohen further shows in Fig. 1A that the yoke 20+28 is formed with straight sided pole tip portions 22 and 30 and overplated yoke portions 28 and 26.

#### Examiner's Note

2. A “product by process” claim is directed to the product per Se, flo matter how actually made, see *In re Hirao*, 190 USPQ 15 at 17 (footnote 3 CCPC, 5/27/76); *In re Brown*, 173 USPQ 685 (CCPA 5/18/72); *In re Luck*, 177 USPQ 523 (CCPA, 4/26/73); *In re Fessmann*, 180 USPQ 324 (CCPA, 1 / 10/74); *In re Thorpe*, 227 USPQ. 964 (cAFC, 11/21/85). The patentability of the final product in a “product by process” claim must be determined by the product itself and not the actual process and an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. In this Application, the elected claims 19-30 all claim a product and the also recite some process related limitations, such as “electrochemically plated,” “had baked,” and “photolithographic process techniques.” These limitations do not gain weight in determining patentability in “product by process” claims.”

Applicant respectfully traverses this ground of rejection and asserts that the claims include limitations that are not taught by the cited prior art. Each of independent claims 19 and 25 basically recite a device including:

1. a component having
2. a head with overhang portions and
3. having photoresist beneath the overhang portions of the head.

Indeed, within each of claims 19 and 25 are further limitations ("electrochemically plated" components and "hard baked" photoresist) which are characterized as being process limitations and therefore have no weight in determining patentability. Therefore, the patentability of claims 19 and 25 basically relies on the above-stated limitations of 1. a component having 2. a head with overhang portions and 3. having photoresist beneath the overhang portions of the head.

Applicant continues to assert that the prior art fails to teach such a device, as is next discussed.

One such component of Applicant's invention that satisfies the limitations of independent claims 9 and 25 is depicted in Fig. 9 of the application and described in page 7, line 24 - page 8, line 2 as:

"As depicted in Fig. 9, owing to the straight, line of sight directional nature of the RIE process, portions 76 of the hard baked photoresist remain beneath the undersurface 40 of the overhanging portion 42 of the mushroom head 38." Emphasis added

As is next described, Cohen '342 fails to teach any such component.

Particularly, within the first paragraph of the above quoted Office Action rejection, component 32A is identified as satisfying the limitation that it has an overplated head. However, component 32A is identified as an induction coil portion, see column 11, lines 55-56. This component 32A is not depicted or described in Cohen '342 as having an overplated head, rather, as depicted in Fig. 2, this component 32A has a flat upper surface upon which an insulative layer 19 is disposed. Furthermore, component 32A has no overhang portions. Therefore component 32A of the prior art does not teach the limitations set forth in independent claims 19 and 25.

The closing phrase of the first paragraph of the rejection as indicates that component 28 of Cohen '342 is such a component as would satisfy the limitations set forth above in claims 19 and 25. Component 28 is identified in col. 11, line 55 as a yoke arm. However there is no teaching or discussion in Cohen '342 that component 28 has an overplated head, nor that it includes overhang portions.

In the above quoted rejection, component 20 is asserted to satisfy the limitations set forth in independent claims 19 and 25. However, component 20 is identified as a yoke arm, see col. 9, line 53, and there is no depiction or teaching in Cohen '342 that component 20 is formed with an overlapped head, nor that it includes overhang portions, nor that any overhang portions are filled with hard baked resist, as is recited in independent claims 19 and 25.

Applicant has thoroughly reviewed Cohen '342 and examined each of the components thereof and the description of the components. There is no depiction or teaching in Cohen '342 of any component that has a head which includes overhang portions, and furthermore there is no depiction or teaching of such a component having photoresist disposed beneath such overhang portions. Applicant therefore respectfully submits that independent claims 19 and 25 are allowable in that they recite limitations not taught in the cited prior art.

With regard to dependent claims 20-24 and 26-30 Applicant respectfully submits that these claims are allowable in that they depend, either directly or indirectly from an allowable base claim.

Regarding paragraph 2 of the Office Action, the Examiner notes that some or all of the claims recite some process related limitations which have no added weight in determining patentability. While Applicant agrees that this is true, the limitations relied upon in distinguishing the prior art are structural limitations (a component with a head having an overhang and with photoresist beneath overhang) and, as argued hereabove, the cited prior art fails to teach such limitations.

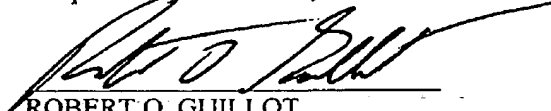
In paragraph 3 of the Office Action it is indicated that Applicant's arguments filed 06/20/2005 have been fully considered but they are not persuasive, stating:

"Applicant's claim is so broad. Cohen et al (US 5,995,342) reads on the claims properly as stated in the rejection presented above. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the features recited above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)."

Responsive thereto, the structural features that Applicant relies upon are a component with a head having an overhang and with photoresist beneath the overhang, as recited in the claims, and Applicant asserts that the prior art fails to teach those features.

Having responded to all of the paragraphs of the Office Action, and having amended the claims accordingly, Applicant respectfully submits that the Application is now in condition for allowance. Applicant therefore respectfully requests that a Notice of Allowance be forthcoming at the Examiner's earliest opportunity. Should the Examiner have any questions or comments with regard to this amendment, a telephonic conference at the number set forth below is respectfully requested.

Respectfully submitted,

  
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Dated: August 19, 2005

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(date)

  
(Signature of Patricia Beilman)